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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,844	03/30/2001	Sadayuki Iwai	205379US0	7041

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ALEXANDRIA, VA 22314

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/23/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/820,844

Applicant(s)

IWAI, SADAYUKI

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52, 54-57, 59-63, 65-68, 70-76, 78-81, 83-87, 89-92 and 94-98 is/are pending in the application.
- 4a) Of the above claim(s) 1-48, 97 and 98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-52, 54-57, 59-63, 65-68, 70-76, 78-81, 83-87, 89-92 and 94-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment mailed February 04, 2003.  
Claims 53, 58, 64, 69, 77, 82, 88 and 93 were canceled and claims 49 and 73 were amended rendering claims 1-52, 54-57, 59-63, 65-68, 70-76, 78-81, 83-87, 89-92 and 94-98 pending with claims 1-48 and 97-98 withdrawn from consideration.

### ***RESPONSE TO REQUEST FOR RECONSIDERATION***

2. Applicant's election with traverse is acknowledged. The traversal is on the ground(s) that "there is no evidence of record to show that the claimed product can be made by forming an intermediate image transfer belt by sintering the transfer belt material" is not persuasive. Examiner would like to reference Larson et al. (U.S. 5,559,592), which teaches sintering an intermediate image transfer belt (column 6, lines 9-65). Applicant also traverses on the ground(s) that, there is no support for the process as claimed being used in an extruding apparatus, is not persuasive. Okuyama et al (U.S. 5,258,154) teaches an intermediate transfer belt used in an extruding apparatus (column 5, lines 26-29). Due to showing references as documentation of the sintered intermediate transfer belt being used in an extruding apparatus, the Examiner deems the restriction requirement to be appropriate. The search of the 2 subclasses would entail the requisite serious burden as the search for composition is not the same as the article search.

The requirement is deemed proper and is therefore made **FINAL**.

***Claim Rejections – 35 USC § 103(a)***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 49-52, 54-57, 59-63, 65-68, 70-76, 78-81, 83-87, 89-92 and 94-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (U.S. 5,978,638).

5. Tanaka discloses an image forming apparatus for forming a toner image by use of an intermediate transfer belt (abstract and column 3, lines 61-67) having a hardness (column 4, line 13). Tanaka discloses the image forming apparatus comprising an elastic layer of rubber (column 5, lines 1-3) and polyurethane material (column 8, line 43 and column 11, line 15). The reference discloses an elastic layer having a JIS-A hardness of 85° or less and a second layer having a thickness of 200 micrometers or less (column 8, lines 7-15) and the first layer has a thickness between 300 micrometers and 3000 micrometers (column 8, lines 19-20).

In claim 49, Applicant discloses an image forming apparatus that includes an image carrier for forming a latent image and for developing said latent image, which is considered to be intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art

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structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Additionally, intended use is given little patentable weight. In claim 49, Applicant further states, 'a first raw liquid material is fed into a hollow, cylindrical mold...' along with 'the first raw material is cured to thereby form a first endless belt layer.' This is product by process claim limitation language that is found throughout Applicants' claims 49 and 73. Although Tanaka does not disclose a gloss value, because the reference discloses an intermediate transfer belt with the same materials as Applicant with the same function, it would have been obvious to one of ordinary skill in the art to include a gloss value, absent any evidence to the contrary.

### ***Response to Arguments***

6. Examiner thanks Applicant for submission of the International Standard ISO 48 corresponding to the JIS A hardness scale standard as claimed.

Arguments made in regards to rejection made under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (U.S. 5,610,691) are persuasive and Takahashi et al is withdrawn due to disclosing a contact charging member versus an intermediate transfer belt.

Arguments made in regards to rejection made under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (U.S. 5,978,638) have been considered but are

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unpersuasive. Applicant argues the scale was indicated as an intended method of use limitation. This is not true, the JIS A scale was not indicated as intended method of use but as a product by process claim limitation. Applicant has indicated the JIS A scale as a hardness factor, therefore the product by process claim limitation rejection, in regards to the JIS A scale has been withdrawn. Applicant argues Tanaka et al fails to disclose a belt containing a first and second belt layer where the first belt layer has a hardness ranging from 30°C to 70°C, as measured by JIS A scale and said second belt layer has thickness ranging from 30 to 1,000 micrometers. Examiner respectfully disagrees because Tanaka discloses an elastic layer having a JIS-A hardness of  $\{85^{\circ}$  or less $\}$  and a second layer having a  $\{$ thickness of 200 micrometers $\}$  or less (column 8, lines 7-15) and the first layer has a thickness between 300 micrometers and 3000 micrometers (column 8, lines 19-20).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

  
ELIZABETH MULVANEY  
PRIMARY EXAMINER